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09/506,434	02/18/2000	Ravi Acharya	47004.000059	8248

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/506,434

Applicant(s)

ACHARYA ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,10,11,13,15,17,21 and 50-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4, 10,11,13,15,17,21 and 50-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 4, 10, 11, 13, 15, 17, 21, and 50-59 are pending. Claims 15, 21, 55, and 59 have been amended in this communication filed 12/08/04 entered as Response After Non-Final Action.
2. The Objection to the Specification and drawing figures 1-3 has been overcome in part as set forth here below. The Objection to Drawing Figure 1 has been overcome by the Applicants' amendments to Figure 1 and is hereby withdrawn.
3. The 112 second paragraph rejection for claim 15 has been overcome by Applicants' amendment to claim 15 and is hereby withdrawn.

### ***Specification***

4. The Specification is objected to because in the figure descriptions the description is not in agreement with Applicants' drawing labels. Figure 2 in the Specification references "enter requested information 230", "missing information 240", and "submit transaction to BOFD for processing 250". The drawing labels "ENTER REQUESTED DATA 230", and "SUBMIT TRANSACTION TO BOFD SYSTEM FOR PROCESSING 250". Figure 3 in the Specification references "security function 305", "terminate process 310", "receive transaction 315", "make decision 345", and "format ECP transaction 360". The drawing labels "Security Function for Authorized User 305", "Terminate Process for Unauthorized User 310", "RECEIVE TRANSACTION DATA FOR CHECK DEPOSIT 315", "Determine Method for Clearing Check 345", and "Format Transaction for ECP 360". The Specification and drawing labels should be in agreement. It is also noted that in some parts of the Specification "data" is referenced

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and in other parts of the Specification "information" is referenced. This should be consistent throughout the Specification. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 10, 11, 13, 50-54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 819,236) Josephson in view of (US 5,751,842) Riach et al, hereafter Riach.

As per claim 1, Josephson teaches, A system for depositing the value associated with conventional checks into the bank account of a customer payee comprising: an interface to a customer terminal, the customer terminal being located remotely from a bank (col. 6, lines 52-67 and fig. 1 –shows an interface to a terminal remotely located from a bank); an automated banking system connected to the customer terminal interface via a communication link, the automated banking system being located remotely from the customer terminal interface (col. 7, lines 1-51, fig. 2, fig. 3, and fig. 5 – shows the steps of depositing a check and sending through a banking system) and an interface to a check clearing system, the check clearing system connected to the automated banking system via a communication link, the check clearing system being located remotely from the automated banking system (col. 7, line 52- col. 8, line 29).

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Josephson failed to teach, wherein the automated banking system is configured such that information from a conventional check is entered into the customer terminal, and wherein the automated banking system and check clearing system are configured to effectuate deposit of the discrete value of each check into an account of the customer payee. Riach teaches, wherein the automated banking system is configured such that information from a conventional check is entered into the customer terminal (col. 4, lines 39-47- the customer enters information from the check into the customer terminal using the keyboard 14), and wherein the automated banking system and check clearing system are configured to effectuate deposit of the discrete value of each check into an account of the customer payee (col. 4, lines 39-47- a funds transfer operation is effected when the value of the check is transferred from the payer's account to the payee's account and this process includes the check clearing process). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the automated banking system is configured such that information from a conventional check is entered into the customer terminal, and wherein the automated banking system and check clearing system are configured to effectuate deposit of the discrete value of each check into an account of the customer payee and to modify in Josephson because such a modification would allow Josephson to have a funds transfer operation that is effected wherein the value of the cheque is transferred from the payer's account to the payee's account.

As per claim 4, Josephson teaches, The system of claim 1, wherein the remote customer terminal comprises a personal computer (col. 6, lines 52-65 and fig. 1).

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As per claim 10, Josephson teaches, The system of claim 1, wherein the remote customer terminal comprises a digital image scanner for data entry (col. 4, lines 3-23).

As per claim 11, Josephson teaches, The system of claim 10, wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (col. 4, lines 47-55).

As per claim 13, Josephson teaches, The system of claim 1, wherein the remote customer terminal comprises a printer for printing receipts or marking checks (fig. 1 (160) shows a printer used for printing receipts or marking checks).

As per claim 50, this independent claim is rejected for the similar rationale as given above for claim 1.

As per claim 51, this dependent claim is rejected for the similar rationale as given above for claim 4.

As per claim 52, this dependent claim is rejected for the similar rationale as given above for claim 10.

As per claim 53, this dependent claim is rejected for the similar rationale as given above for claim 11.

As per claim 54, this dependent claim is rejected for the similar rationale as given above for claim 13.

As per claim 56, this dependent claim is rejected for the similar rationale as given above for claim 11.

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7. Claims 15, 17, 55, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,819,236) Josephson in view of (US 5,933,816) Zeanah et al, hereafter Zeanah.

As per claim 15, A computerized method for allowing a bank customer to deposit the value of conventional checks into a bank account from a location that is remotely situated with respect to a bank comprising: Josephson teaches, (a) receiving conventional checks payable to a bank customer payee (col. 8, lines 1-11); and entering transaction data into the customer terminal (col. 6, lines 61-65, col. 8, lines 6-11, and fig. 1 (130- a keyboard for entering transaction data)); (d) processing the discrete value of each check for deposit by the automated banking system (col. 8, lines 12-29); and (e) receiving by the bank customer a result of the transaction for each check (col. 8, lines 34-40 and lines 49-57).

Josephson failed to teach, logging the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank, and the automated banking system. Zeanah teaches, (b) logging the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank, and the automated banking system (col. 20, lines 29-39). It would have been obvious to one having ordinary skill in the art at the time the invention was made to log the bank customer payee onto an automated banking system from a customer terminal that is remotely situated with respect to a bank and the automated banking system and to modify in Josephson because such a

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modification would allow Josephson to have a secure customer terminal for transacting business in an automated banking system.

As per claim 17, Josephson teaches, The method of claim 15 wherein the result of the transaction in step (e) comprises denial (col. 10, lines 17-25).

As per claim 55, this independent claim is rejected for the similar rationale as given above for claim 15.

As per claim 59, this independent claim is rejected for the similar rationale as given above for claims 1, 17, and 55

8. Claims 21, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,819,236) Josephson in view of (US 6,012,048) Gustin et al, Gustin.

As per claim 21, Josephson teaches, A computerized method for allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location comprising: (a) receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system (col. 4, lines 56-65 and col. 5, lines 26-63 and fig. 1);

Josephson failed to (b) authorizing a bank customer payee as a user on the automated banking system; (c ) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer;



Gustin teaches, authorizing a bank customer payee as a user on the automated banking system (fig. 8 (300, 308, & 310), fig. 8A, and 8B –shows authorizing a customer payee as a user of the automated banking system)); (c ) receiving transaction data related to the deposit of a conventional check payable to the bank customer, where the payor is someone other than the bank customer (col. 12, lines 3-47, col. 19, line 56 – col. 20, line 63, Fig. 13 E, Fig. 13 F, fig. 20, fig. 20A, Fig. 20B, fig. 20C, Fig., 20E, and Fig. 20F); and (d) processing the transaction for the discrete value of each check (col. 20, line 44- col. 22, line 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Josephson because such a modification would allow Josephson to have the payment accepted for each check for the amount of the face value (amount written on the face of the check).

As per claim 57, Josephson teaches, The method of claim 56, wherein entering transaction data into the customer terminal comprises scanning the checks using the digital image scanner (col. 4, lines 3-23).

As per claim 58, Josephson teaches, The method of claim 55, wherein the result of the transaction in (e) comprises a provisional credit to the associated demand deposit account (col. 10, lines 17-25).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 4, 10, 11, 13, 15, 17, 21, and 50-59 filed 12/08/04 have been considered but are not deemed persuasive.

Issue no. 1: Applicants' argue: Applicants' respectfully submit that this cited section of Josephson does not disclose a customer terminal and Josephson does not

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disclose that the invention is operable by a customer terminal has been considered but is not persuasive. Response: Applicants' argument is traversed. It is interpreted that the computer in Josephson has a video monitor that allows a user (customer) to interact. Josephson's customer terminal has the features of Fig. 1 (101, 103, 102, and 104).

Issue no. 2: Applicants' argue: Riach also does not disclose, nor is it asserted that Riach discloses, "an interface to a customer terminal, the customer terminal being located remotely from a bank" and this limitation is not disclosed in a combination of Josephson and Riach, and this combination of references does not form a prima facie case of obviousness of the invention of claim 1 has been considered but is not persuasive. Response: It is interpreted that Riach teaches an interface to a customer terminal the customer terminal being located remotely from a bank is a self-service terminal for entry of a customer's bank card which is interpreted as being remote and an interface is defined as a connection between two systems through which information is exchanged (the document is feed at a terminal and moved through a transport system then to a processing system which is connected over line 40 to provide a visual display of the document and a bus connection 72 is present in the processing system.

Issue no. 3: Applicants' argue: In the cited sections of Josephson and Riach, there is no disclosure of an automated banking system connected to a customer terminal interface via a communication link and there is not disclosure that the PC is operable as a customer terminal has been considered but is not persuasive. Response: The PC in Josephson is a user (customer) terminal that can be used to transact business with a bank or financial institution.

Issue no. 4: Applicants' argue: There is no disclosure in the cited sections of Josephson of receiving conventional checks payable to a bank customer payee and entering transaction data into the customer terminal has been considered but is not persuasive. Response: Josephson teaches receiving conventional checks payable to a bank customer payee and entering transaction data into the customer terminal in col. 8, lines 1-11, col. 6, lines 61-65 and col. 8, lines 6-11, and figure 1 (130-a keyboard for entering transaction data).

Issue no. 5: Applicants' argue: Josephson in combination with Zeanah does not disclose a method for allowing a bank customer to deposit the value of a conventional check into a bank account from a remote location comprising entering transaction data from a conventional check into the customer terminal that is remotely located from an automated banking system, and processing the discrete value of each check for deposit by the automated banking system (claim 55) or processing a check deposit transaction initiated by a bank customer at a remote location comprising receiving transaction data of a conventional check payable to a bank customer from a customer terminal that is remotely located from the automated banking system and processing the transaction for the discrete value of the check (claim 59) has been considered but is not considered persuasive. Response: Claim 55 recites "(a ) receiving conventional checks payable to a bank customer payee; (b) logging the bank customer payee onto an automated banking system from a customer terminal that was previously associated with a demand deposit account of the bank customer payee, wherein the customer terminal is remotely located from the automated banking system, wherein further access to the customer

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terminal is controlled by the bank customer payee; (c) entering transaction data into the customer terminal; (d) processing the discrete value of each check for deposit by the automated banking system from the customer terminal into the associated demand deposit account; and (e) receiving a result of the transaction for each check.” In response to Applicants’ arguments, the recitation a method for allowing a bank customer to deposit the value of a conventional check into a bank account from a remote location comprising entering transaction data from a conventional check into the customer terminal that is remotely located from an automated banking system, and processing the discrete value of each check for deposit by the automated banking system (claim 55) or processing a check deposit transaction initiated by a bank customer at a remote location comprising receiving transaction data of a conventional check payable to a bank customer from a customer terminal that is remotely located from the automated banking system and processing the transaction for the discrete value of the check (claim 59) has not been given patentable weight because the part of the recitation to these claims occurs in the preamble and the Examiner does not find the remainder of the claim recitation in the claim language of claims 55 and 59. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicants' are respectfully requested in the response to this office action to point out these claim limitations in claims 55 and 59 to the Examiner.

Issue no. 6: Applicants' argue: Gustin does not disclose the limitations not disclosed by Josephson of allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location comprising receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system has been considered but is not persuasive. Response: In response to applicant's arguments, the recitation "allowing a bank to process check deposit transactions that are initiated by a bank customer at a remote location comprising" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Examiner does not interpret these claim limitations "receiving a request from a bank customer on a terminal that is remotely situated from a bank for authorization to make a transaction using an automated banking system, wherein the terminal is remotely situated from the automated banking system" as being recited, suggested or disclosed in claim 21.

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Conclusion: Applicants' are respectfully requested to point out to the Examiner in the independent claims the inventive concept and to distinctly claim the inventive concept in the claim language.

A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Josephson, Riach, Zeanah, and Gustin, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

*During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<*

### **Conclusion**

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


#### **Inquiries**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
February 19, 2005